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| 10/066,310      | 02/01/2002  | Ronald Newbold       | 04-1403             | 2364             |

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EXAMINER

NGUYEN, CHI Q

ART UNIT PAPER NUMBER

3635

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/066,310

Applicant(s)

RON NEWBOLD

Examiner

Chi Q Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-17 is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10, 18-26, and 30-49 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 27-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office action is in response to the applicant's amendment and terminal disclaimer filed on 12/23/03.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 23, 26, 39, 40, 42, 44, 47, 48, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Monson (US 6,105,334).

Monson teaches a fire resistant lighting enclosure comprising an electrical fixture 12, a rectangular housing 10. The housing 10 having outer layer made out of metal (col. 3) and having a top wall 20, four sidewalls 22-28, bottom walls 32-38, inner layer comprises fire-resistant rating material 50 that substantially enclosing the electrical fixture 12 such that the housing 10 and the electrical fixture 12 form a preassembled integral unit (fig. 1). The housing 10 enclosing the electrical fixture 12 in a manner such that the housing 10 is configured to form a substantially continuous surface (fig. 6), joists 62, 64, the metal outer layer function as a support structure for the electrical fixture, a piece of sheet rock 66 could be used as fire resistant material and is attached to the joists 62, 64. The housing 10 is constructed from sheet metal (col. 3, lines 59-62).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25, 30, 31, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monson (US 6,105,334).

With regard to claim 24, Monson teaches the structural elements for the recess electrical fixture as stated except for the housing comprises a cube-shaped box. It would have been an obvious matter of design choice to have a cube-shaped box for desirable uses.

With regard to claims 25, 30, 31, 43, Monson teaches the structural elements for the recess electrical fixture as stated except for the fire-resistant material is selected from the group consisting of drywall, plaster material, and the drywall material comprises sheet rock. Since in the applicant's specification, page 9, lines 15-16, stated that the dry wall or wallboard materials include sheet rock, plywood, asbestos cement sheets, gypsum, therefore examiner takes Official Notice the fact that the fire-resistant of a sheet rock drywall material would have been functional equivalent to the cementitious and intumescent fire-resistant materials because they're performed the similar function such as preventing fire penetration.

Claims 32-38, 41, 45, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monson (US 6,105,334) in view of Hentz (US 6,116,750).

With regard to claims 32, 33, 34, 36, 41, Monson teaches the structural elements for the electrical fixture as stated except for the housing also including a generally fire-resistant gasket. Hentz teaches recess light fixture including a gasket 6. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Monson with Hentz for a gasket. The motivation for doing so would have been to seal an air gap. With regard to claim 35, Monson teaches the structural elements for the electrical fixture as stated except for the fire-resistant material comprises a material selected from the group consisting of drywall, plaster. Since in the applicant's specification, page 9, lines 15-16, stated that the dry wall or wallboard materials include sheet rock, plywood, asbestos cement sheets, therefore, examiner takes Official Notice the fact that the fire-resistant of drywall would have been functional equivalent to the cementitious and intumescent fire-resistant materials because they're performed the similar function such as preventing fire penetration. With regard to claim 38, Monson teaches the structural elements for the electrical fixture as stated except for the gasket is made by of a material selected from the group consisting of fiberglass, foam, and rubber. Hentz teaches recessed light fixture including a rubber gasket 66 (col. 7, lines 52-53). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Monson with Hentz for a rubber gasket for housing fixture. The motivation for doing so would have been to provide a resilient gasket to seal gaps around the electrical housing thus preventing leaks.

With regard to claims 37, 45, Monson and Hentz teach the structural elements for the electrical fixture including the metal housing as stated. Monson and Hentz do not

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teach specifically a material for the housing is made of aluminum. Examiner considers this would have been an obvious design choice because aluminum is a group of metal material and aluminum is well known material for free of corrosion.

Claims 1, 2, 3, 4, 5, 9, 10, 18, 19, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monson (US 6,105,334) in view of Horng (US 6,561,762).

With regard to claims 1, 2, 5, and 18, 19, Monson teaches the structural elements for the electrical fixture as stated. Monson does not teach expressly a housing that enclosing a recessed fan assembly. However, Monson's disclosure (col. 5, lines 49-50) teaches the housing or enclosure could for other recessed fixtures as well. Therefore, Horng teaches a housing structure of a fan assembly as shown in figures 4-8. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Monson with Horng for recessed fan assembly. The motivation for doing so would have been to provide a recessed enclosure for a fan assembly.

With regard to claims 3, 4, 20, and 21, Monson and Horng teach the structural elements for the recessed electrical/fan assembly as stated except for the fire-resistant material is selected from the group of drywall, plaster material, and the drywall material comprises sheet rock. Since the applicant's specification, page 9, lines 15-16, stated that the drywall or wallboard materials include sheet rock, plywood, asbestos cement sheets, gypsum, therefore, examiner takes Official Notice the fact that the fire-resistant of a sheet rock drywall material would have been functional equivalent to the cementitious and intumescent fire-resistant material because they're performed the similar function such as preventing fire penetration.

***Allowable Subject Matter***

Claims 6, 7, 8, 27, 28, 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11-17 are allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 1-5, 9, 10, 18-26, 30-49 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (703) 308-0839. The fax number for the organization where this application or proceeding assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

1113.

  
CQN  
4/12/04

  
Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600